



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,269	04/08/2004	Torsten Schulz	15111.0081	8565
27890	7590	02/12/2009		
STEPTOE & JOHNSON LLP		EXAMINER		
1330 CONNECTICUT AVENUE, N.W.		LUNDGREN, JEFFREY S		
WASHINGTON, DC 20036		ART UNIT	PAPER NUMBER	
		1639		
			MAIL DATE	DELIVERY MODE
			02/12/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>		Application No. 10/820,269	Applicant(s) SCHULZ ET AL.
		Examiner JEFFREY S. LUNDGREN	Art Unit 1639
<p><b>–The MAILING DATE of this communication appears on the cover sheet with the correspondence address –</b></p> <p>THE REPLY FILED 27 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p>1. <input type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires 3 months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> <p><b>NOTICE OF APPEAL</b></p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p> <p><b>AMENDMENTS</b></p> <p>3. <input type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).</p> <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____. </p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input type="checkbox"/> will not be entered, or b) <input checked="" type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p> <p>The status of the claim(s) is (or will be) as follows:</p> <p>Claim(s) allowed: _____</p> <p>Claim(s) objected to: _____</p> <p>Claim(s) rejected: <u>1-24, 44 and 45</u></p> <p>Claim(s) withdrawn from consideration: <u>25-43</u>.</p> <p><b>AFFIDAVIT OR OTHER EVIDENCE</b></p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fail to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p> <p><b>REQUEST FOR RECONSIDERATION/OTHER</b></p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  <u>See Continuation Sheet</u></p> <p>12. <input type="checkbox"/> Note the attached <i>Information Disclosure Statement(s)</i>. (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____</p> <p>/ Christopher S. F. Low /  Supervisory Patent Examiner, Art Unit 1636</p>			

Continuation of 11. does NOT place the application in condition for allowance because: Applicants traverse the rejection with a number of comments that do not consider the art as a whole, and misplace the context of the references that are relied upon in the outstanding rejections. Applicants allege on page 9 of their Reply filed on January 27, 2009, that: "(a) none of references teach all of the claimed limitations; (b) that the references do not stand for the teachings assigned to them; and (c) there is no reason or motivation to combine the references so as to arrive at the claimed." These statements are simply incorrect.

Regarding Applicants' contentions that "none of the references teach all of the claimed limitations," it should be well understood by Applicants that a rejection based upon 35 USC § 103(a) relies on multiple teachings for demonstrating that all of the claim limitations were known and obvious between the combination of references. There is no requirement that one reference teach all of the limitations as stated by Applicants. Such considerations are reserved for 35 USC § 102.

Applicants' assertions the Blackburn disclosure does not teach a recess is incorrect (see page 9 of Applicants' Reply, second paragraph in the "Blackburn" section). When one considers the function role of a gasket it is infact to provide a "recess" and the volume in the "recess" can provide an open volume or can be filled (e.g., similar to an o-ring). Therefore, the gaskets disclosed throughout Blackburn meet the claim limitation of "a sealing intermediate having an enclosed recess". This concept is also applicable to Applicants other arguments regarding the references not teaching "a recess".

Regarding Applicants arguments directed to the lack of teaching by Ehricht, such comments are incorrect, as it is the combination of Ehricht and other three references that teaches all of the limitations. For example, Ehricht teaches a chamber body, a chamber support and a sealing connection, and these elements are held together in a fixable manner such as by an adhesive or weld. The other teachings, such as Paul, clearly show how one may also rely on "holding elements" such as those shown in Figure 3 of Paul. The rejection under 35 USC § 103(a) is therefore maintained.